

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Seiji KONDOU et al.**

Art Unit: **1792**

Application Number: **10/563,865**

Examiner: **Alain L. Bashore**

Filed: **January 9, 2006**

Confirmation Number: **1943**

For: **PROCESS FOR PRODUCING COATED SHEET, OPTICALLY
FUNCTIONAL LAYER, OPTICALLY COMPENSATING PLATE,
OPTICAL DEVICE AND IMAGE DISPLAY**

Attorney Docket Number: **053537**
Customer Number: **38834**

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

January 21, 2009

Sir:

This paper is submitted in response to the Office Action dated December 9, 2009.

In the Office Action, Applicants are required to elect one of the following groups of claims for prosecution in this application:

- (I) claims 1-11 directed to a method
- (II) claims 12-16 directed to a product

Applicant(s) hereby elect(s) the subject matter of **Group (I), original claims 1-11** for prosecution in this application. It is submitted that **pending claims 17-36** correspond to Group (I). This election is made **with traverse**, as set forth below, and it is understood that Applicants' rights to the filing of a divisional application directed to the non-elected subject matter under 35 U.S.C. §120 and 35 U.S.C. §121 are retained.

Reconsideration and withdrawal of the restriction requirement is respectfully requested.

As a preliminary, it is submitted that the preliminary amendment filed with the national stage application canceling claims 1-16 and adding new claims 17-36 directed to methods and claims 37-42 directed to products, has not been taken into account. Thus, Group (I) corresponds to pending claims 17-36.

Further, it is submitted that the restriction requirement is in error because it applies the “independent and distinct” rule for restriction, which is applicable to regular (national) U.S. applications, instead of the PCT “unity of invention” rule applicable to U.S. national stage applications.

Under the restriction rules for regular U.S. applications, restriction between product and process claims is proper if the product can be used in a different method or the method can result in a different product. See MPEP 806.05(f). In contrast, this issue is not relevant under the “unity of invention” rule, as discussed above. See MPEP 1893,03(d).

Since the present application is a US national stage of a PCT application, the standard of unity of invention applies. The requirement of unity of invention is satisfied when there is a technical relationship among claims involving one or more of the same or corresponding special technical features. The expression "special technical features" means the technical features that define a contribution which each of the claimed inventions makes over the prior art. See 37 CFR § 1.475(a).

In particular, as provided at 37 CFR § 1.475(b), a national stage application containing claims to different categories of invention can be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- A product and a process specially adapted for the manufacture of said product; or
- A product and process of use of said product; or
- A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- A process and an apparatus or means specifically designed for carrying out the said process; or
- A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

Thus, it is submitted that a restriction requirement under the PCT “unity of invention” rule would be incorrect if applied to pending claims 17-42, because the present claims correspond to product and process especially adapted for the manufacture of such product.

In view of the above, it is submitted that the restriction requirement should be withdrawn.

Application No.: 10/563,865
Art Unit: 1792

Response to Restriction Requirement
Attorney Docket No.: 053537

If this paper is not timely filed, Applicant(s) respectfully petition(s) for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

/nicolas seckel/

Nicolas E. Seckel
Attorney for Applicants
Registration No. 44,373
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

NES/rep